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08/928,272	09/12/1997	MICHAEL J. ISKRA	P-3818	9434

7590

09/17/2003

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EXAMINER

PATEL, MITAL B

ART UNIT	PAPER NUMBER
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32

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 32

Application Number: 08/928,272
Filing Date: September 12, 1997
Appellant(s): ISKRA, MICHAEL J.

MAILED
SEP 16 2003
GROUP 3700

Scott J. Rittman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/3/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1 and 5-9 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

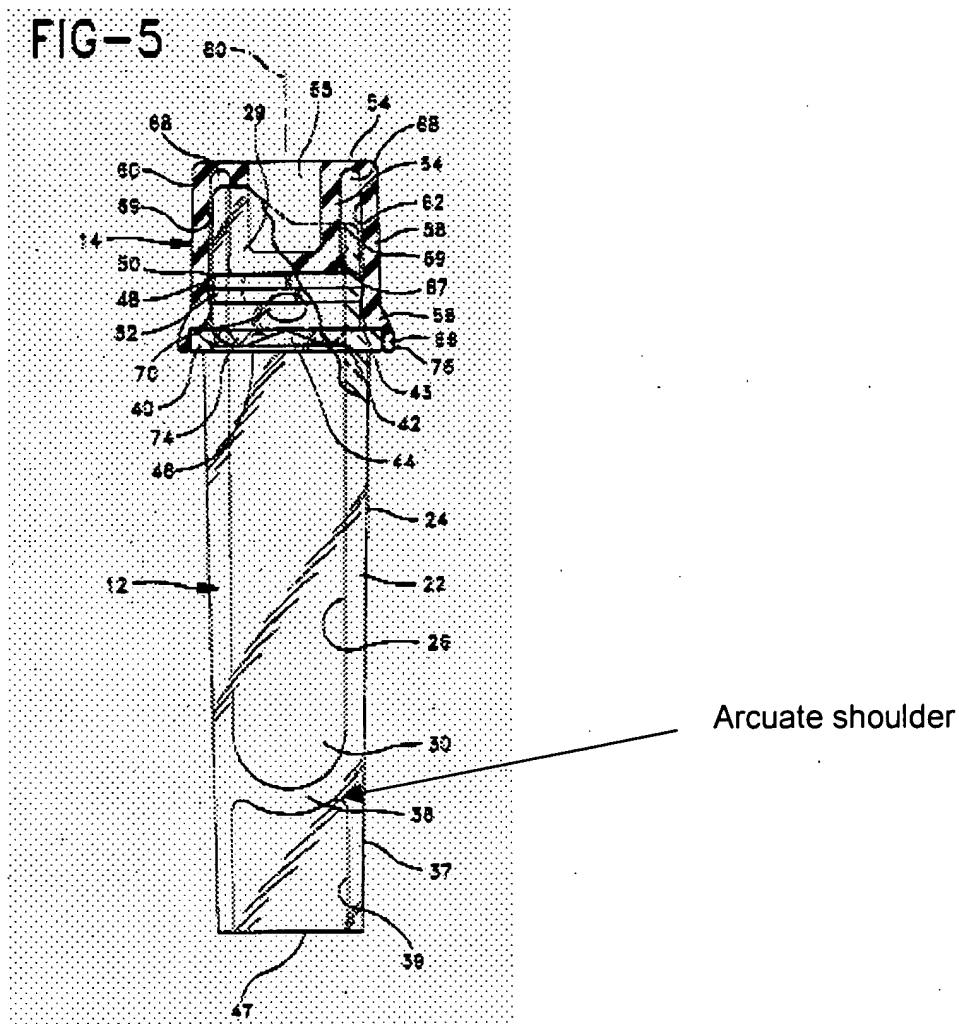
1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 5, 7, and 8 rejected under 35 U.S.C. 102(b) as being anticipated by Burns (US 5458854).

3. As to claim 1, Burns teaches a one-piece collection container assembly comprising an elongate tubular housing having opposed first and second ends ; and a solid partition **38** positioned within the housing between the first and second ends; the housing defining a volume for specimen collection therein between the first end and the partition; the second end comprising a bottom end below said partition, the bottom end comprising a rounded bottom having an opening **47** therein (also see Figure 5 attachment below). Please note that the Examiner maintains that Burns teaches a rounded bottom (See Fig. 1 which depicts the bottom to be rounded).



4. As to claim 5, Burns teaches an assembly wherein the partition is arcuate in shape to provide the volume for specimen collection with at least a partially rounded bottom portion.

5. As to claim 7, Burns teaches an assembly wherein the housing is a thermoplastic polymer.

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6. As to claim 8, Burns teaches an assembly wherein the thermoplastic polymer is polyethylene terephthalate, polypropylene, polyethylene naphthalate, polyvinyl chloride or copolymers thereof.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burns.

9. As to claim 6, Burns fails to specifically teach an assembly wherein the partition is conical in shape. However, the shape of the partition is a mere design choice that can be obtained through routine observation and experimentation. Furthermore, the Applicant fails to disclose why one particular shape would be advantages over another or what particular purpose is served by a conical shaped partition or how the specific shape provides an unexpected result and therefore, it would be obvious to one of ordinary skill in the art to make the partition of any desired shaped absent criticality.

10. As to claim 9, Burns fails to specifically teach an assembly wherein the housing has the particular dimensions as set forth by the claim. However, the Applicant fails to disclose why those particular dimensions are advantageous or what particular problem those specific dimensions solve. Furthermore, depending on the intended use, e.g.,

how much sample is to be collected, the dimensions of the housing will vary and such dimensions may also be derived through routine observation and experimentation and therefore, it would be obvious to one of ordinary skill in the art to make the housing of any desired dimensions.

(11) Response to Argument

11. In response to Appellant's arguments that Burns does not disclose a rounded bottom with an opening therein, please refer to the attached drawing Figure 5 from the Burns reference which shows that Burns teaches a rounded bottom with an opening **47**. Furthermore, Appellant contends that "the Examiner takes the position that the partition **38** of Burns constitutes Appellant's claimed rounded bottom." Please note that the Examiner makes no such statement either explicit or implicit in the Office Action that element **38** constitutes both the partition and rounded bottom. The Examiner would like to offer this clarification that the rounded bottom constitutes the opening **47**.

12. In response to Appellant's arguments with respect to motivation and modifying the Burns reference to arrive at a rounded bottom, please note that there is not a 35 U.S.C. 103 rejection with respect to a rounded bottom but rather a 35 U.S.C. 102(b) rejection and as such Appellant's arguments with respect to motivation and modification of the Burns reference to arrive at a rounded bottom are moot.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

Examiner Mital B. Patel
September 9, 2003

Conferees

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